

combination made by applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor). Here, there is nothing which would have led one of ordinary skill in this art to make use of the data files of Longinotti in the application of Su.

In fact, the only suggestion or teaching which would direct one of ordinary skill in this art to a method as presently claimed is found in applicant's disclosure of the invention in the Specification and claims. However, use of that information would constitute impermissible hindsight in the construction of the rejection under 35 USC 103(a). In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Applicant would argue that identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, as set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) "To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the [applicant]. Here, there is no such motivation, suggestion or teaching which would have reasonably led those skilled in this art to use the data file of Longinotti in the system disclosed by Su. Further, even if such a substitution or combination was reasonable, one skilled in the art would still not have the data application as presently claimed.

Thus, applicant would urge that the evidence provided by the Examiner is not sufficient to reasonably support the conclusion of obviousness reached. Therefore, applicant would request reconsideration and withdrawal of this ground of rejection under 35 U.S.C. 103(a).

The Rejection of claims 42-45 and 62:

At pages 14-17 of the Office action of October 26, 2007, the Examiner sets forth the basis and reasoning in support of the rejection of claims 42-45 and 62 under 35 U.S.C. 103(a) as unpatentable over Su (20030084124) taken in view of RSS 2.0

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Specification at Harvard Law, July 15, 2003.

The Examiner urges that Su discloses the limitations of claim 42, and thus claims 43-45 and 62, as discussed with regard to claim 35 on which it depends. However the Examiner acknowledges (page 16 of the Office action) that Su fails to "teach the the claimed aspect that the information data is fed RSS. However, the Examiner urges that RSS 2.0 at Harvard Law, July 15, 2003 discloses RSS web content syndication format. The Examiner concludes that "It would be obvious to one of ordinary skill in the art at the time of the invention to combine Su's display system with RSS 2.0 because it allows one web site to share information with another web site.

Applicant would initially note that the claimed invention does not relate to the sharing of data between two web sites as described. Further, at best, it can be said that the RSS 2.0 at Harvard Law, July 15, 2003 would inform one skilled in this art that the format exists. It does not suggest the use of the format in a particular system, such as that of Su or, for that matter, the present invention. Similarly, Su does not suggest or direct one to this particular format.

Applicant would, also, renew the argument set forth above that Su does not disclose the presently claimed invention of claim 35 on which 42 depends. As such, it would not have been obvious to modify that which Su discloses in a manner which would have resulted in the presently claimed invention. In addition, what is missing from this analysis is anything to be found in the prior art which would have suggested such a combination of the two teachings.

As noted above, it is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by applicant.

Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor). Here, there is nothing which

would have led one of ordinary skill in this art to make use a particular format, such as the RSS format, merely because it was out there.

Thus, the present rejection is flawed for the same reason as the rejection of claim 41 under 35 U.S.C. 103(a). Therefore, applicant would request reconsideration of this ground of rejection and the withdrawal of the rejection of claims 42-45 and 62 under 35 U.S.C. 103(a) as unpatentable over Su when taken in view of the RSS document.

The Rejection of claims 61 and 63:

At pages 18-19 of the Office action of October 26, 2007, the Examiner sets forth the basis and reasoning in support of the rejection of claims 61 and 63 under 35 U.S.C. 103(a) as unpatentable over Su (20030084124) taken in view of Bolle (6,892,193).

The Examiner urges that Su discloses the limitations of claim 61 and 63, as discussed with regard to claims 35 and 46 on which they depend. However the Examiner acknowledges (page 19 of the Office action) that Su fails to "teach the aspect of generating a personal note annotation, categorizing by color and manually select the files." However, the Examiner notes that Bolle in 6,892,193 discloses the claimed aspect of file category is assigned a different colour to distinguish one category of said personal note from another category, wherein media items are categorized (or classified) based both on textual features and visual features, including color properties and motion properties of key intervals.

Thus, the Examiner concludes that "It would be obvious to one of ordinary skill in the art at the time of the invention to combine Su's display system with Bolle's file management concept of annotation, categorization by color, and manually select the files, because this would allow users more efficient file management practices.

Applicant would initially note that Bolle does not relate to or mention color coded note pads as required by claim 61. Further, Bolle is making use of "visual features including, but not limited to color properties of **key intervals**." (See Abstract). It is not readily apparent how this coloring system relates to either the system of Su or that of the present invention. Again, as with the other rejections under 35 U.S.C. 103(a), there is

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also no suggestion, reason or motivation to be found in the prior art itself that would suggest the use of the categories system of Bolle in the system of Su.

To the extent that it can be argued that Bolle demonstrates that a color system is useful in categorizing data segments, it remains that there is nothing which would have led one skilled in the art to combine this particular teaching with that of Su. Even if so combined, it is not readily apparent that you would arrive at the presently claimed system.

As previously pointed out, merely because the components of a claimed invention can, individually, be found in the prior art, this is not sufficient, standing alone, to reasonably support a conclusion of obviousness within the meaning of 35 U.S.C. 103.

Thus, the present rejection is flawed for the same reason as the rejections of other claims under 35 U.S.C. 103(a). Therefore, applicant would request reconsideration of this ground of rejection and the withdrawal of the rejection of claims 61 and 63 under 35 U.S.C. 103(a) as unpatentable over Su when taken in view of the Bolle.

Conclusion:

Applicant has addressed each ground of rejection, individually. However, the core factor remains that Su simply does not disclose the type of system presently claimed in claims 35 and 46, on which all other claims depend either directly or indirectly. For this reason, no matter how Su could be modified, in view of the teaching of the other references noted by the Examiner, it remains that one skilled in this art would not have arrived at the claimed invention. Thus, Applicant, respectfully, requests reconsideration of all grounds of rejection of record, withdrawal of all grounds of rejection and a determination that all claims are allowable.

Should any official at the United States Patent and Trademark Office deem that any further action by the Applicant or Applicant's undersigned representative is desirable and/or necessary, the official is invited to telephone the undersigned at the number set forth below.

The Commissioner is hereby authorized to charge any fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to

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deposit account No. 503321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 503321.

Respectfully submitted,

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